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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,604	11/20/2000	Mark Goldston	J1-9-03755-B-US	3290

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EXAMINER

WILLETT, STEPHAN F

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,604

Applicant(s)

GOLDSTON, MARK

Examiner

Stephan F. Willett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/16/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RD

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable Nishio et al. with Patent Number 6,381,651 in view of Schmid et al. with Patent Number 6,438,578.

3. Regarding claim(s) 1, 12, 20, 28, Nishio teaches providing plural categories of human interest as “fields (genres)”, col. 3, lines 57-58 and categories have respective scopes as “hobbies”, etc., col. 5, lines 1-4. Nishio teaches activating a client on the local device, col. 3, lines 15-17 and a web browser requesting a first page, col. 4, lines 47-49. Nishio teaches after the web browser requests a web page, the client automatically obtaining one of the plural of categories in which the web page belongs as page “summary information” etc. ., i.e. “keyword, , col. 5, lines 17-21, and “information identifier”, col. 5, line 21. Nishio teaches after the category is obtained automatically obtaining a recommended web page which is in one of the categories, col. 10, lines 8-14; col. 9, lines 36-28. Nishio teaches the client outputting a message to the output device which informs the user of a recommendation, col. 10, lines 48-52. Nishio teaches the user providing input to the client indicative of the user’s desire to activate the recommendation and in response causing the browser to request the second or recommended

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page, col. 11, lines 15-21. Nishio teaches the browser requesting the second page and outputting the second page to the output device, col. 12, lines 12-15. Nishio teaches the invention in the above claim(s) except for explicitly teaching not registering a user and not entering or referring to a user profile. In that Nishio operates to categorize data in a computer network, the artisan would have looked to the network data referral management arts for details of implementing other options. In that art, Schmid, a related network data referral communication system, teaches “network server determines whether a request is a second request”, col. 6, lines 19-20 in order to provide relevant data. Schmid specifically teaches “to cause the network client to request supplemental information”, col. 6, lines 42-43, but never registration information and the user who did not enter profile information such as past requests, col. 8, lines 52-44. Further, Schmid suggests identifying “the supplemental information to the network client as having originated with the requested information source”, col. 7, lines 14-16 which will result from initial request, however, the initial request may have been technically “registered”, but the user did not register. The motivation to incorporate no registration insures other methods of pushing data. Thus, it would have been obvious to one of ordinary skill in the art to incorporate none registration as taught in Schmid into the communication system described in Nishio because Nishio operates with unregistered referrals and Schmid suggests that optimization can be obtained by providing unregistered referrals. Therefore, by the above rational, the above claims are rejected.

4. Regarding claim(s) 2, 13, 21, 29, Nishio teaches the step of the client obtaining the recommendation after the user provides input as “provided to a user” which is in the past tense, col. 4, line 4 and then new pages are recommended.

5. Regarding claim(s) 3, 31, Nishio teaches the client is an independent program as the “ID server judges whether the new home page suits the favorites of the user” which is independent of user/client, col. 3, lines 26-28.

6. Regarding claim(s) 4, 14-15, 22-23, 30, 32, Nishio teaches providing a page categorization database correlated to categories of human interest, col. 8, lines 48-54 and col. 14, lines 21-28. Nishio teaches looking up the first page in the database to correspond the page with one of categories of interest, i.e. “music”, col. 14, line 9-14.

7. Regarding claim(s) 5, 16, 24, Nishio teaches the web browser storing a resource locator (URL) corresponding to the first page as “information identifiers”(ID), col. 14, lines 50-54 and specifically a URL, col. 17, lines 22-23, 34-37. Nishio teaches the client copying or using the URL or ID for looking up the first page in a correlation table based on content as “subject ID” col. 14, lines 55-60.

8. Regarding claim(s) 6, Nishio teaches the first page locator is an URL, col. 5, lines 21-25.

9. Regarding claim(s) 8, 34, Nishio teaches the output device is a display for pages, col. 11, lines 25-29.

10. Regarding claim(s) 7, 17, 25, 33, Nishio teaches providing plural categories of human interest as “fields (genres)”, col. 3, lines 57-58 and categories have respective scopes as “hobbies”, etc., col. 5, lines 1-4. Nishio teaches activating a client on the local device, col. 3, lines 15-17 and a web browser requesting a first page, col. 4, lines 47-49. Nishio teaches after the web browser requests a web page, the client automatically obtaining one of the plural of categories in which the web page belongs as page “summary information”, col. 5, lines 17-21. Nishio teaches after the category is obtained automatically obtaining a recommended web page

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which is in one of the categories, col. 10, lines 8-14. Nishio teaches the client outputting a message to the output device which informs the user of a recommendation, col. 10, lines 48-52. Nishio teaches the user providing input to the client indicative of the user's desire to activate the recommendation and in response causing the browser to request the second or recommended page, col. 11, lines 15-21. Nishio teaches the browser requesting the second page and outputting the second page to the output device, col. 12, lines 12-15. Nishio teaches the invention in the above claim(s) except for explicitly teaching providing the user with the option to access a next recommended page. In that Nishio operates to categorize data in a computer network, the artisan would have looked to the network data referral management arts for details of implementing other options. In that art, Schmid, a related network data referral communication system, teaches "network server determines whether a request is a second request", col. 6, lines 19-20 in order to provide relevant data. Schmid specifically teaches "to cause the network client to request supplemental information", col. 6, lines 42-43. Further, Schmid suggests identifying "the supplemental information to the network client as having originated with the requested information source", col. 7, lines 14-16 which will result from implementing the referral and there are no limits on the number of supplemental requests possible. The motivation to incorporate multiple recommendations insures user demand is met. Thus, it would have been obvious to one of ordinary skill in the art to incorporate multiple recommendations as taught in Schmid into the communication system described in Nishio because Nishio operates with multiple referrals and Schmid suggests that optimization can be obtained by providing multiple or supplemental referrals. Therefore, by the above rational, the above claims are rejected.

11. Regarding claim(s) 9, 18, 26, 35, Schmid teaches automatically recommending a third page as a "supplemental page" based on categories, col. 6, lines 48-56 and after the "first request" is a second request" or recommendation, col. 5, lines 9-11 and in response the client causing a third page to be outputted, col. 7, lines 12-13.

12. Regarding claims 10-11, 19, 27, 36-37, the Nishio patent discloses the method of the preceding claims. The Nishio patent does not explicitly disclose providing recommendations for free or charging an account. However, Official Notice is taken MPEP 2144.03 (a)) that providing recommendations for free or charging an account is well known in the art to insure adequate rewards for development are satisfied or marketing is enhanced. It would have been obvious to one of ordinary skill in the art at the time of the application's invention to provide recommendations for free or charging a an account to obtain the advantages of profit or marketing. By the above rational, the claims are rejected.

Response to Amendment

1. The broad claim language used is interpreted on its face and based on this interpretation the claims have been rejected.

2. The limited structure claimed, without more functional language, reads on the references provided. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

3. Pursuant to MPEP 2111.02, the weight afforded the preamble of the claims is many times not clear. In claims 1, 12, 28 the elements in the preamble are not clear in interpreting the claims

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since the element(s) are not positively recited in the body of the claim to provide the element(s) their patentable weight.

4. Applicant suggests “without referring to a user profile of any kind”, Paper Filed 5/18/05, Page 13, lines 13-14. “[The] specification, having described the whole, necessarily described the part remaining”, In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977), see also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983) and “negative limitations extended to define the invention in terms of what it was not, rather than pointing out the invention”, MPEP 2172.05(I). A negative type limitation, that implicitly teaches other related parts remaining, to avoid obvious elements of a reference does not exude novelty of the whole. In addition, as argued “the initial request may have been technically ‘registered’, but the user did not register”, Paper Filed 5/18/05, Page 13, lines 8-9 which reads on “a user who has not entered a profile” in claim 1, as does the user who did not enter profile information such as past requests, col. 8, lines 52-44 in Schmid. Arguably the “user’s history file” as well as a “category of human interest” are both profiles since the recommendation must be based on something. Thus, Applicant’s arguments can not be held as persuasive regarding patentability.

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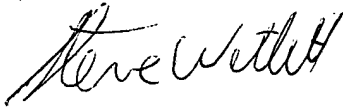
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is disclosed in the Notice of References Cited. A close review of the references is suggested. The other references cited teach numerous other ways to perform network web page referrals, thus a close review of them is suggested.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephan Willett whose telephone number is (571) 272-3890. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey, can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

7. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



Stephan Willett

Patent Examiner

July 8, 2005